

REMARKS

Claims 1 to 24 were pending in the application at the time of examination. Claims 1 to 24 stand rejected as obvious.

Applicants have amended Claims 1, 10, 12, 15, and 22 to clarify that the user is the author of the document in that "user entered input data user," and "user inputted a request to enter reference data" show that the user is not a programmer of computer code. This was done to remove any confusion as to inherent characteristics of the elements recited in the claims that should be considered in an obviousness rejection. Moreover, when the claims were interpreted in view of the specification, these amendments are clearly inherent in the original claims.

Claims 1 to 5, 8 to 19, and 22 to 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,289,342 B1, hereinafter Lawrence, in view of U.S. Patent No. 5,867,678, hereinafter Amro.

In the Advisory Action, the Examiner stated, in part:

Examiner submits it should be understood by one of ordinary skill in the art that an assistant agent's function is to perform tasks based on user's instructions; therefore, it is similar to that of the user performing the tasks on his own. Hence, Lawrence implicitly teaches the limitation as claimed.

The Examiner previously stated:

...Lawrence utilizes the help of an assistant agent to perform tasks on **behalf of the user**, making interaction with the software system easier and/or more efficient (col. 5, lines 20-25). Since the user instructs the assistant agent to find, extract, and store the citation information, it is equivalent to that of the user performing the tasks on his/her own. (Emphasis in original.)

However, Lawrence stated:

The third area of prior work is assistant agents. The present invention can be viewed as an assistant agent.

Lawrence, Col. 5, lines 20, 21.

Lawrence describes the invention, and thus the assistant agent of Lawrence, as:

An Autonomous Citation Index autonomously creates a citation index from literature in electronic format [printed literature can be converted to electronic form using optical character recognition (OCR)]. An ACI system autonomously locates new articles, extract citations, identifies citations to the same article which occur in different formats, and identifies the context of citations in the body of articles. The viability of autonomous citation indexing depends on the ability to perform these functions accurately.

Lawrence, Col. 5, lines 50, 58.

Thus, Lawrence stated that the ACI system is the assistant agent. The person that directs the ACI system of Lawrence to autonomously locate new articles, extract citations, identify citations to the same article which occur in different formats, and identify the context of citations in the body of articles is the programmer of the ACI system.

As previously pointed out, Lawrence stated, "the present invention does not require any extra effort on the part of the authors beyond placement of their work on the web." Thus, the author that puts the text and citations in the document does not do anything or input anything to the assistant agent of Lawrence. Accordingly, the Examiner comments directly contradict the teachings of Lawrence, as has been consistently pointed out.

Applicants previously pointed out the MPEP sections that require the Examiner to consider the express teaching of Lawrence, because Lawrence is what establishes the level of skill in the art. If the Examiner continues to maintain that

the level of skill is different from that taught by Lawrence, the Examiner is respectfully requested to cite prior art that shows the teaching of Lawrence would be ignored and a different definition used, or in the alternative to provide an Examiner's affidavit that provides the requisite information.

Applicants did not indicate that there was not a suggestion to combine the two references as indicated in the advisory action, but rather the combination failed to satisfy the MPEP requirements for making the combination. Applicants stated and repeat:

Nevertheless, the Examiner asserts, as quoted above, that based upon Amro, Lawrence would be modified to store the data in a particular way. The problem is that Lawrence is not creating a document as recited in Claim 1.

Lawrence explicitly states that the author places the document of the World Wide Web and Lawrence generates a searchable citation index using documents placed on the World Wide Web.

Again, Applicants note the MPEP states:

THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE
OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

MPEP § 2143.02, 8th Ed. Rev 1., p. 2100-127, (Feb. 2003).

Changing an autonomous citation indexing system that finds and generates a citation index to reformat documents and store new information in such documents would require a change in the principle of operation of Lawrence. Similarly, modifying the other index system mentioned in Lawrence and cited by the Examiner would suffer from similar problems. In particular, the fact that Lawrence would have to modify every document found on the World Wide Web shows the impracticality of the modification. Lawrence is addressing a completely different problem than the problem addressed by Applicants.

The Examiner has failed to cite any teaching or suggestion of:

entering user inputted text data for said computer-readable document in a data file;

determining whether a user inputted a request to input reference data;

entering user inputted reference data into the reference database following said determining finding said user inputted said request to input reference data; and

storing the reference database, said user inputted text data, and other data of the computer-readable document in said data file wherein said other data includes at least one citation to said user inputted reference data,

as recited in Claim 1. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claims 2 to 5, 8 and 9 depend from Claim 1 and distinguish over the combination of references for at least the same reasons as Claim 1. Applicants request reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 5 and 8 to 9.

Claim 6 stands rejected as obvious in view of Lawrence and Amro taken together with U.S. Patent No. 5,097,418, hereinafter Nurse. However, assuming that the combination of the three references is correct and that the interpretation of the three references is correct (Applicants note that by making these assumptions Applicants do not concede that either of these facts is correct), the additional information from the third reference does not correct the deficiencies of the two primary references as noted above with respect to Claim 1 and incorporated herein by reference. Applicants request

reconsideration and withdrawal of the obviousness rejection of Claim 6.

The obviousness rejection of Claim 10 relied upon the same information as discussed above for Claim 1. Claim 10 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 10 and is incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 10.

Claim 11 depends from Claim 10 and so distinguishes over the combination of references for at least the same reasons as Claim 10. In addition, the text cited by the examiner described operation of a parsing module, which again is unrelated to anything recited in Claim 11. Downloading and then parsing a document is unrelated to the apparatus recited in Claim 11. Again, the MPEP requires that the claims be considered as a whole and not be distilled to a gist. See MPEP § 2141.02, p. 2100-121. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 11.

The obviousness rejection of Claim 12 relied upon the same information as discussed above for Claim 1. Claim 12 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 12 and is incorporated herein by reference.

Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 12.

Claims 13 and 14 depend from Claim 12 and so distinguish over the combination of references for at least the same reasons as Claim 12. Applicants request reconsideration and withdrawal of the obviousness rejections of Claims 13 and 14.

The obviousness rejection of Claim 15 relied upon the same information as discussed above for Claim 1. Claim 15 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is

applicable to Claim 15 and is incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 15.

Claims 16 to 19 depend from Claim 15 and so distinguish over the combination of references for at least the same reasons as Claim 15. Applicants request reconsideration and withdrawal of the obviousness rejections of each of Claims 16 to 19.

In the obviousness rejection of Claim 20, the Examiner cited an additional reference. However, assuming that the combination of the three references is correct and that the interpretation of the three references is correct (Applicants note that by making these assumptions Applicants do not concede that either of these facts is correct), the additional information from the third reference does not correct the deficiencies of the two primary references as noted above with respect to Claim 15. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 20.

Claim 21 depends from Claim 20 and so distinguishes over the combination of references for at least the same reasons as Claim 20. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 21.

The obviousness rejection of Claim 22 relied upon the same information as discussed above for Claim 1. Claim 22 also includes language equivalent to that discussed above for Claim 1. Therefore, the above discussion of Claim 1 is applicable to Claim 22 and is incorporated herein by reference. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 22.

Claim 23 depends from Claim 22 and so distinguishes over the combination of references for at least the same reasons as Claim 22. Applicants request reconsideration and withdrawal of the obviousness rejection of Claim 23.

Claims 7 and 24 stand rejected in view of Lawrence, Amro, and Kanerva, which was used in the first rejection. Again, this rejection requires the same combination of references as in Claim 1 and then looking to yet a third reference that describes another unrelated system, as previously pointed out. The above discussion with respect to Lawrence and Amro is incorporated herein by reference, as is the discussion of Kanerva in the prior response. Applicants request reconsideration and withdrawal of the obviousness rejections of Claims 7 and 24.

Claims 1 to 24 remain in the application. For the foregoing reasons, Applicants respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicants.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 12, 2004.



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April 12, 2004
Date of Signature

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